

REMARKS

This RCE submission is filed in accordance with 37 CFR 1.114. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

The Drawings

An amended drawing is submitted with this response. As noted above, this amendment consists of the deletion of the unnecessary label "FIG. 1." A replacement sheet of drawings bearing this amendment, is submitted with this submission. This amendment overcomes the objection raised under 37 CFR § 1.84(u).

Claim Amendments

In this response, it is proposed to amend claims 1 and 12. More specifically, it is proposed to amend claim 1 to assume partially closed form, while it is proposed to amend claim 12 to call for a single reflective layer. Withdrawn method claim 17, has also been amended so that it corresponds to claim 12 in content and should therefore be rejoined and allowed.

Withdrawn Claims

Applicants submit that the request for reconsideration of the withdrawal of claims 17-20 was intended to be a request for "rejoinder" and not a traverse of the propriety of restriction requirement *per se*. In fact, claims cannot be "rejoined" unless they are withdrawn. Therefore, the defense of the restriction requirement, in the Advisory Action, as a grounds for refusing rejoinder, is misdirected. The fact that the claims stand withdrawn is not at issue. What is at issue is that the PTO has, in the notice published in *Official Gazette* on March 26, 1996, established guidelines for the treatment of product and process claims in light of *In re Ochiai* and *In re Brouwer*. It was assumed that the Examiner would have been aware that this notice dealt with rejoinder and the issues associated therewith.

More specifically, where product and process claims drawn to independent and distinct inventions are presented in the same application, a restriction requirement may

be made. The examiner may thus, where appropriate, require applicant under 35 U.S.C. 121 to elect claims to either the product or process. Claims directed to the non-elected invention are withdrawn from further consideration under 37 CFR 1.142. If applicant elects claims directed to the product, and the product is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product will be rejoined. Examiners should review the restriction requirement to determine whether it is still applicable. Where the restriction requirement is no longer applicable, the requirement should be withdrawn when the process claims are rejoined.

Rejections under 35 USC § 102

The rejection of claims 1-16 under 35 US § 102(b) as being anticipated by Kaduk et al., is respectfully traversed.

Kaduk et al. teach the provision of four layers 9, 10, 11 and 12. Layer 9 is a thin clear layer formed of TiO₂. Layer 10 is a reflective layer which is formed of particulate TiO₂. Layer 11 is an undercoat which can comprise a mixture of MgO/Al₂O₃, and layer 12 is a phosphor coating.

The position taken by the Patent Office renders it such that Kaduk et al. must be taken as disclosing two reflective layers. That is to say, the TiO₂ layer which is specifically disclosed as being a reflective layer and the MgO/Al₂O₃ layer which this Office Action insists is known to be reflective *per se*.

Claim 1 distinguishes over this by permitting only one reflective layer, while the second independent claim 12 distinguishes over the same by reciting that a single light transmissive and UV reflecting layer is disposed on the inner surface of the lamp envelope. As will be appreciated, the use of a single layer simplifies production and reduces the cost of the final product.

The Kaduk et al. reference cannot meet these requirements because, if the position taken by the PTO in this rejection is correct – there are two reflective layers in the Kaduk et al. arrangement in the location where the claims permit only one.

It is respectfully requested that the Examiner enter the amendments proposed in connection with claims 1 and 12 and allow the application along with the pending method claims. If not, the Applicants must request, in accordance with MPEP 2144.03,

that the Examiner present references to substantiate the position that a) the claimed $\text{MgO}/\text{Al}_2\text{O}_3$, is known to be a reflective material and 2) that the $\text{MgO}/\text{Al}_2\text{O}_3$ layer in Kaduk et al. is inherently reflective.

More specifically, the Applicants seasonably challenges the veracity of these positions. This is the first time in the prosecution of this application that either of these assertions has been advanced and as such the Applicants seasonably challenge the same in accordance with MPEP 2144.03. The Examiner is thus requested to furnish a reference or references which demonstrate that $\text{MgO}/\text{Al}_2\text{O}_3$ layer is 1) known to be UV reflective and further that 2) it will produce this effect each and every time that it is used and thus be established as possessing these alleged inherent properties in accordance with current patent law.

Conclusion

It is respectfully submitted that all of the pending product claims are patentable over the cited reference. The withdrawn process claims are seen to contain all of the necessary corresponding limitations and thus rejoinder and allowance of this application with all pending claims is courteously solicited.

Respectfully submitted,

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